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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,657	03/20/2001	Margaret Ann Johns	5947-01-DRK	4802

7590

09/17/2002

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EXAMINER

GUCKER, STEPHEN

ART UNIT

PAPER NUMBER

1647

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/787,657

Applicant(s)

Johns et al.

Examiner

Stephen Kueker

Group Art Unit

1647

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 3/15/02
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-34 is/are pending in the application.
- ☐ Of the above claim(s) is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☐ Claim(s) is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☒ Claim(s) 1-34 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

***Election/Restrictions***

1. This application was filed as a 35 USC 371 application: Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-7, 15-16, and 21, drawn to polynucleotides and first method of use of such.

Group II, claim(s) 13-14, drawn to a diagnostic assay for mutations.

Group III, claim(s) 19, drawn to a method of protecting against calcium flux.

Group IV, claim(s) 20, drawn to a method of treating or preventing epilepsy.

Group V, claim(s) 22-26, drawn to polynucleotides other than from Group I.

Group VI, claim(s) 8-10, drawn to polypeptides.

Group VII, claim(s) 11, drawn to antibodies.

Group VIII, claim(s) 12, drawn to method of using antibodies.

Group IX, claim(s) 17-18, drawn to a screening assay using polypeptides.

Group X, claim(s) 27-29, drawn to polypeptides other than from Group VI.

Group XI, claim(s) 30, drawn to antibodies other than from Group VII.

Group XII, claim(s) 31-32, drawn to methods to treat diseases with polynucleotide

sequences.

Group XIII, claim(s) 33, drawn to methods to screen for diseases with polynucleotide sequences.

Group XIV, claim(s) 34, drawn to methods of binding of polynucleotides to gabapentin.

2. Restriction to one of the following inventions is also required under PCT Rule 13.1:

Inventions 1-133 as they pertain to SEQ ID NO: 1-16, 18-41, 43-49 or any one of the sequences not listed as a separate SEQ ID NO in claims 31, 33, or 34 (86 other sequences). The sequences are distinct, one from the other, and each appears to constitute a separate invention requiring a separate sequence search, absent evidence to the contrary. If a sequence not listed as a separate SEQ ID NO from the sequence listing is elected as the invention, Applicant is required to submit a new sequence listing (paper copy and CRF) as required by the sequence rules. For fragments of larger sequences that have a SEQ ID NO, a new SEQ ID NO need not be created, as it is preferable to list fragments of larger sequences as nucleotides or residues (e.g. nucleotides 1-100 of SEQ ID NO:3) of the larger sequence.

3. The inventions listed as Groups I-XIV and inventions 1-133 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reason: the technical feature of Group I appears to be a nucleotide sequence encoding a subunit for a calcium channel. However, this technical feature is not shared by the other Groups because they are drawn to diagnostic assay for mutations, protection against calcium flux, a method of treating or preventing epilepsy,

polynucleotides other than from Group I, polypeptides, antibodies, method of using antibodies, a screening assay using polypeptides, polypeptides other than from Group VI, antibodies other than from Group VII, methods to treat diseases with polynucleotide sequences, methods to screen for diseases with polynucleotide sequences, or methods of binding of polynucleotides to gabapentin. Therefore, the technical feature of Groups I does not constitute a special technical feature linking the groups because a nucleotide sequence encoding a subunit for a calcium channel is not shared by all the groups.

Accordingly, the Groups I-XIV are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

4. The inventions are also distinct, each from the other because of the following reasons:

A national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept. If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application will be considered as the main invention in the claims, see PCT article 17(3)(a) and 1.476(c), 37 C.F.R. 1.475(d).

5. A telephone message for Mehdi Ganjeizadeh was left on 9/9/02 in an attempt to restrict by phone, but Applicant requested a written restriction on 9/13/02.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

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amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

7. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Gucker whose telephone number is (703) 308-6571. The examiner can normally be reached on Monday to Friday from 0930 to 1800. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623. The fax phone number for this Group is currently (703) 308-4242, but Applicant should confirm this by phoning the Examiner before faxing.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Stephen Gucker

September 16, 2002

